

REMARKS

The Office Action dated September 9, 2004 has been carefully reviewed. Claims 1-13 are pending in this application. Claims 1-13 stand rejected. Reconsideration of the rejected claims in light of the remarks presented herein is respectfully requested.

Filed concurrently herewith is an executed copy from each of the inventors of a Revocation and Appointment of Power of Attorney. Please direct all future correspondence to the address listed thereon.

35 U.S.C. § 103 REJECTIONS

Claims 1-13 were rejected under 35 U. S. C. § 103(a) as being obvious over U. S. Patent No. 6,340,935 issued to Hall (hereinafter "Hall") in view of U.S. Patent No. 6,032,126 issued to Kaehler (hereinafter "Kaehler"). Reconsideration of these claims in light of the remarks presented herein is respectfully requested.

Discussion Re: Patentability of Claim 1

Independent claim 1, as filed, is as follows:

comprising:
and
a payment terminal including;
means for assessing a payment amount;
means for receiving a payment amount;
means for opening said exit gate upon receipt of the payment amount; and
means for providing two-way video and audio communication with a monitoring facility remote from said payment terminal.

1. An automated payment system for a parking facility,
an exit gate operable to control egress from the parking facility;

The proposed combination of Hall and Kaehler does not arrive at the invention of claim 1 since it does not include each and every limitation of claim 1. Indeed, the parking facility management system of Hall does not disclose an automated payment system having an exit gate that is opened based operation from a payment terminal, and certainly does not disclose an automated payment system having a two-way video and audio communication means. This is likely because Hall appears to be directed largely to systems for tracking vehicles and vehicle locations within a garage in which access to the garage is controlled by use of access cards. Although a limited

discussion of "charge-for-parking" facilities is present in Hall, such a discussion does not disclose an automated payment system as recited in claim 1. Kaehler is directed to automated fuel dispensers, and does not cure the deficiencies of Hall when combined therewith.

The Examiner has identified many features and functions of the system of Hall in the 9/9/04 Office Action (see, e.g., last partial paragraph of page 2 through first partial paragraph of page 3). The Examiner indicated that "Hall teaches all the elements of the claimed invention." Applicants respectfully disagree, and request that the Examiner identify how such features or structures read on the specific limitations of claim 1. In particular, if the rejection of claim 1 is maintained after considering the remarks presented herein, the Examiner is respectfully requested to specifically indicate (e.g. by line and column number and/or figure number and reference number) where each limitation of claim 1 is disclosed in Hall (or Kaehler).

Even if proposed combination could be shown to arrive at the invention of claim 1, a notion that Applicants disagree with, there is no legally sufficient teaching, suggestion, or motivation to combine such references. The rule of law for a finding of obviousness under 35 U.S.C. § 103(a) was reiterated recently by the Court of Appeals for the Federal Circuit as follows, "[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In re Lee*, 277 F.3d 1338 at 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002); See also *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 at 1351-52, 60 USPQ2d 1001 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors). The Federal Circuit expounded upon the necessity of finding some teaching or motivation to combine the references *in the references themselves* concluding that "[t]he factual inquiry whether to combine references must be thorough and searching." *In re Lee*, 61 U.S.P.Q.2d at 1433 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination *must be found in the prior art*, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In an apparent attempt to establish a case of obviousness based on these references, the Examiner stated that:

"The motivation for the change would have been permitting the customer to initiate and complete an extended transaction from one location, yielding added convenience to the customer. Likewise, the change offers enhanced marketing and sales without hindering traffic flow." (see 9/9/04 Office Action, page 4, lines 1-4).

The Examiner has in no way identified how the references expressly or impliedly suggest the purported motivation. Applicants argue that the purported motivation simply cannot be supported as legally sufficient. Indeed, the Examiner asserts that the motivation would permit "the customer to initiate and complete an extended transaction." However, a careful reading of Hall does not identify a need for such capability since the customer does not perform any transaction that could even remotely be construed as "extended." Indeed, the system of Hall generally does not interact with the customer, but rather primarily interacts with the garage manager. For example, the customer is "interacted with" by the system of Hall when (i) the system displays information relating to available parking spaces by use of the displays 50, or (ii) when the customer swipes his or her parking card to gain access to the garage. Neither of these, nor any other interactions with the customer discussed in Hall, could be reasonably construed as an "extended transaction." "Extended" customer transactions simply do not exist in the system of Hall. Because of this, and for numerous other reasons, one skilled in the art would clearly not be motivated to go to the relatively high expense and effort to incorporate the audio and video link of Kaehler into the system of Hall as proposed by the Examiner.

It appears that the Examiner has relied on the Applicants' disclosure to the identify a motivation for combining the references. Such use of the Applicants' specification is not proper under the holding of the *Lee* court, and the numerous other judicial holdings relied upon by the *Lee* court. If this is not the case, and the Examiner has indeed relied upon some motivation present in the references, Applicants respectfully request that the Examiner identify with particularity (e.g. by line and column number within the references) where the basis for the purported motivation exists.

Discussion Re: Patentability of Claims 2-4

Each of claims 2-4 includes claim 1 as a base claim. As a result, each of claims 2-4 is allowable for the reasons hereinbefore discussed with regard to claim 1.

Discussion Re: Patentability of Claim 5

The discussion relating to the patentability of claim 1 is relevant to the patentability of claim 5. For example, claim 5 includes the limitation "means for providing two-way video and audio communication between said central monitoring facility and said payment terminal at each of said plurality of exit facilities". As a result, claim 5 is allowable for the reasons hereinbefore discussed with regard to claim 1. Specifically, not only does the proposed combination of Hall and Kaehler not arrive at the invention of claim 5, there is no legally sufficient motivation for combining them in the first place.

Discussion Re: Patentability of Claims 6-9

Each of claims 6-9 includes claim 5 as a base claim. As a result, each of claims 6-9 is allowable for the reasons hereinbefore discussed with regard to claim 5.

Discussion Re: Patentability of Claim 10

The discussion relating to the patentability of claim 1 is relevant to the patentability of claim 10. For example, claim 10 includes the limitation "a two-way video and audio communication system linking the automated payment system with a monitoring facility remote from the automated payment facility". As a result, claim 10 is allowable for the reasons hereinbefore discussed with regard to claim 1. Specifically, not only does the proposed combination of Hall and Kaehler not arrive at the invention of claim 10, there is no legally sufficient motivation for combining them in the first place.

Discussion Re: Patentability of Claims 11-13

Each of claims 11-13 includes claim 10 as a base claim. As a result, each of claims 11-13 is allowable for the reasons hereinbefore discussed with regard to claim 10.

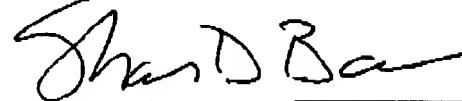
Conclusion

In view of the foregoing amendments and remarks, it is submitted that this application is in a condition for allowance. Action to that end is hereby solicited.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages

in other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 37837-75702.

Respectfully submitted,
BARNES & THORNBURG



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